

REMARKS

Favorable reconsideration and allowance are respectfully requested. Claims 1-46 are pending. By this amendment, claim 40-46 are canceled without prejudice to Applicants' right to pursue one or more divisional applications directed to the subject matter of the canceled claims, and claims 1-2 have been amended to address one or more of the rejections discussed below. Therefore, the amendments to the claims do not introduce new matter. Claims 1-39 remain pending and at issue.

Rejections Under 35 U.S.C. § 112, First & Second Paragraph

Claims 1-39 and 41-46 were rejected under 35 U.S.C. 112, second paragraph, as allegedly indefinite because of the recitations "prodrug thereof". In addition, claims 1-39 and 41-46 were rejected under 35 U.S.C. 112, first paragraph, for failing to enable prodrugs of the claimed compounds. Still further, claims 1-9 and 11-17 were rejected under 35 U.S.C. 112, first paragraph, for failing to enable solvates and hydrates of the claimed compounds. (The Examiner concedes that the specification is enabling for making pharmaceutically acceptable salts of the claimed compounds. Applicants thank the Examiner for acknowledging the enablement of salts of the claimed compounds.) Finally, claims 41-46 were rejected under 35 U.S.C. 112, first paragraph, for failing to enable the treatment of conditions associated with abnormal cell growth or the treatment of all cancers.

Without conceding the propriety of any of the rejections of the instant claims under Section 112 and purely in the interests of advancing prosecution on the merits of the present application, Applicants have amended the claims to delete references to prodrugs, solvates or hydrates of the claimed compounds. Applicants have also canceled the method of treatment and pharmaceutical composition claims, claims 41-46. Applicants have further canceled claim 40 in order to pursue the subject matter of that claim in a subsequent application. Applicants reserve the right to pursue one or more divisional applications directed to the subject matter of the deleted claims. Thus, the rejections under Section 112 are moot in view of Applicants' amendments to the claims.

Rejections Under 35 U.S.C. §§ 102 & 103

Claims 1-3, 13, 18-20, 22, 24-27, 29, 33, 34, 36, and 41-46 were rejected under 35 U.S.C. 102(e) as allegedly anticipated by Kath et al., US2004/0220177 (referred to below as the "'177 application"). Applicants traverse this rejection for the following reasons.

Section 102(e) provides, in pertinent part, that a "person shall be entitled to a patent unless . . . (e) the invention was described in . . . an application for patent . . . *by another* filed in the United States before the invention by the applicant for patent . . . (emphasis added)" Applicants note that the '177 application does not qualify as an application for patent *by another* because the '177 application lists the same inventors as the instant application and it is owned and assigned by the same assignee as the instant application, i.e., the inventors on both applications are Michael J.

Luzzio and John C. Kath and the assignee for both applications is Pfizer, Inc.. Therefore, because the inventive entity is identical in both applications, the '177 application is not prior art to the instant application and the rejection should be withdrawn.

Claims 1-46 were rejected under 35 U.S.C. 102(e) as allegedly anticipated by Kath et al., US2005/0009853 (referred to below as the " '853 application"). Applicants respectfully note that the '853 application is the instant application. This apparent clerical error therefore renders the instant rejection moot.

Claims 1-46 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over the '177 application. Applicants traverse this rejection. For the reasons discussed above, the '177 application is not available prior art under Section 102(e). Therefore, because it is not available under Section 102 it cannot be the basis for a rejection under Section 103. Reconsideration and withdrawal of the rejection are respectfully requested.

Finally, claims 1-46 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over the '853 application. For the reasons discussed above, Applicants submit that the '853 application is not prior art and it therefore, cannot be the basis for a rejection of the instant claims. Reconsideration is requested.

In view of the foregoing remarks, Applicants submit that the rejections under Sections 102 and 103 should be withdrawn.

Double Patenting Rejection(s)

Claims 1-46 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-30 of copending application USSN 10/734039 (referred to above as the " '177 application"). Moreover, claims 1-46 were also provisionally rejected for obviousness-type double patenting as allegedly unpatentable over claims 1-26 of USSNs 11/122,515 and 11/127,809 (the " '515" and " '809" applications, respectively). As these are provisional rejections, Applicants request that the Examiner hold the provisional rejections in abeyance pending the determination of allowable subject matter in each application. If the instant application should be placed in condition for allowance prior to the determination of allowable subject matter in the '177, '515, and '809 applications, the MPEP provides that the instant application should be allowed to issue and the double patenting rejections may be maintained in one or more of the pending applications that remain.

Amendment re 9/20/05 Official Action
Application No. 10/733,215

CONCLUSION

Favorable consideration of the foregoing amendments and remarks are respectfully requested. If, after consideration of this Amendment the Examiner maintains that there are issues that remain an impediment to allowance, he is invited to telephone the undersigned to discuss such issues.

Date: December 20, 2005

Pfizer Inc.
Patent Dept., 5th Fl.
150 East 42nd Street
New York, NY 10017-5755

Respectfully submitted,



Pamela C. Ancona, Ph.D.
Attorney for Applicants
Reg. No. 41,494
(212) 733-6031.